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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,862	02/20/2004	Kazuhiro Fujimaki	Q80021	4469
65565	7590	01/10/2008	EXAMINER	
SUGHRUE-265550			LEE, SIN J	
2100 PENNSYLVANIA AVE. NW			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037-3213			1795	
			MAIL DATE	DELIVERY MODE
			01/10/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/781,862

Applicant(s)

FUJIMAKI, KAZUHIRO

Examiner

Sin J. Lee

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 8, 10, 11, 13 and 15 is/are rejected.
- 7) ☒ Claim(s) 6 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In view of the amendment, previous 102(e) rejections over Munnelly'460 and over Munnelly'811 are hereby withdrawn.
2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Claim Rejections - 35 USC § 103***

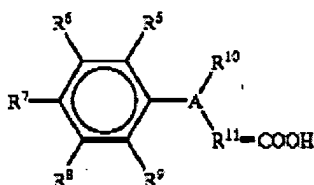
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-3, 5, 7, 8, 10, 11, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munnelly et al (US 2003/0118939 A1).

Munnelly teaches the following in claim 13:

13. A printing plate precursor, comprising:

a substrate; and

coated on said substrate an IR-sensitive composition comprising: a polymeric binder; and a free radical polymerizable system consisting of: at least one component selected from unsaturated free radical polymerizable monomers, oligomers which are free radical polymerizable and polymers containing C=C bonds in the backbone and/or in the side chain groups; and an initiator system comprising: (a) at least one compound capable of absorbing IR radiation; (b) at least one compound capable of producing radicals; and (c) at least one carboxylic acid represented by the formula:



wherein each of  $R^5$ ,  $R^6$ ,  $R^7$ ,  $R^8$  and  $R^9$  is independently selected from the group consisting of: hydrogen, alkyl,

aryl, halogen, alkoxy, hydroxyalkyl, carboxyalkyl, alkylthio, alkylsulfonyl, sulfonic, alkylsulfonate, dialkylamino, acyl, alkoxycarbonyl, cyano and nitro; wherein  $R^5$  and  $R^6$ ,  $R^6$  and  $R^7$ ,  $R^7$  and  $R^8$ , or  $R^8$  and  $R^9$  together optionally form an aromatic or aliphatic ring; wherein  $R^{10}$  is selected from the group consisting of: hydrogen, alkyl, aryl, hydroxyalkyl, carboxyalkyl, acyl, alkoxycarbonyl, alkylsulfonyl and alkylsulfonate; or  $R^{10}$  and its bond together optionally form an electron pair; or  $R^9$  and  $R^{11}$  together optionally form a ring; wherein  $R^{11}$  is an alkylene group of  $C_1$ - $C_8$  carbon atoms; and wherein  $R^{10}$  and  $R^{11}$  together optionally form an aliphatic ring; wherein  $A$  is a heteroatom selected from the group consisting of: N, O and S; with the proviso that the total acid number of said polymeric binder is 70 mg KOH/g or less.

Based on this teaching, it would have been obvious to one skill in the art to have the compound (c) shown above, in which  $R^5$ - $R^9$  are H atoms,  $A$  is N,  $R^{10}$  is an alkoxycarbonyl group ( $-C(=O)-OR$ ) and  $R^{11}$  is an alkylene group of  $C_1$  carbon atom (i.e.,  $-CH_2-$ ), in Munnelly's composition with a reasonable expectation of obtaining a high

speed negative working thermal printing plate. Such compound teaches present compound of formula (I) or (I-2). Therefore, Munnelly's teaching renders obvious present inventions of claims 1-3, 5, 7, 8, 10, 11, 13 and 15.

***Allowable Subject Matter***

5. Claims 6 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Munnelly does not teach or suggest present compound (A) of claim 6 or present R3 group of claim 12.

***Response to Arguments***

6. Applicants argue that Munnelly'939 prefers that its compound (c) contain at least two carboxyl groups. However, in [0053], Munnelly clearly teaches that his compound (c) can be monocarboxylic acid as well as polycarboxylic acid. Also, in [0118], Munnelly states that while polycarboxylic acids are preferred, monocarboxylic acids are also suitable for use in his IR sensitive composition. Applicants argue unexpectedly superior results of present invention by pointing to the data in Tables 2, 4 and 5 in present specification. Such comparative data were carefully considered but were found to be unpersuasive in showing unexpectedly superior results of present invention because the comparison was not made to the closest prior art. See MPEP 716.02(e).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333.

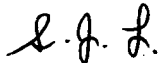
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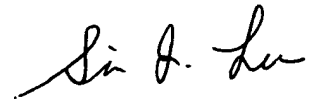
The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Lee  
January 7, 2008



**SIN LEE**  
**PRIMARY EXAMINER**